



2837

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT

Application No.: 10/057,187

) Date: September 4, 2003

Applicant: Shoichi Toyoda

) Examiner Kimberly R. Lockett  
) Group Art Unit 2837

Filed: January 23, 2002

) Our Ref: 619463-7/RPB:TGC

For: "Butterfly Damper"

) B-4466

#7  
D.M. Mark  
9-12-03  
Response

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This paper responds to the Office Action dated June 4, 2003. **All remarks herein are made without prejudice.**

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**REMARKS****Double Patenting Rejection**

In section 1 of the Office Action, the Examiner rejects claims 1-9 under 35 USC 101 as claiming the same invention as that of claims 1-8 of copending application no. 10/057,186. This rejection is respectfully traversed.

Under MPEP 804A (Statutory Double Patenting - 35 USC 101), “[i]n determining whether a statutory basis for a double patenting rejection exists, the question to be asked is: Is the same invention being claimed twice? ... ‘Same invention’ means identical subject matter. ... A reliable test for double patenting under 35 USC 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent.”

Claims 1-9 of the present application clearly do not claim **identical** subject matter with claims 1-8 of copending application no. 10/057,186. For example, claim 1 of copending application no. 10/057,186 recites, in part, “said at least one arm member has substantially a rectangular cross section with four curved corners having a predetermined radius of curvature, in a perpendicular direction to a longitudinal direction of said at least one arm member”. These limitations are not recited in claims 1-9 of present application. Moreover, claim 1 of the present application recites, in part, “an outer circumferential frame having opposite end surfaces and an inner

peripheral surface, said inner peripheral surface being connected to said opposite end surfaces to form opposite connecting edge portions” and “said one end of said at least one arm member is connected to a portion of said inner peripheral surface of said outer circumferential frame, said portion excluding said opposite connecting edge portions”. These limitations are not recited in claims 1-8 of copending application no. 10/057,186.

In section 1 of the Office Action, the Examiner states that “[t]he difference between the two applications is the cross section with four curved corners” and that “[i]t would have been obvious ... to modify the application of 10/057187 to include the cross section as disclosed in 10/057186 in order to provide an efficient means of attaching speaker components.”

Since the Examiner admits that there are differences (cross section with four curved corners) between claims 1-9 of the present application and claims 1-8 of copending application no. 10/057,186, the rejection under 35 USC 101 is clearly improper. Even if such difference is obvious (which the Applicant disagrees), the Examiner can only issue an **obviousness-type double patenting rejection**, which can be overcome by filing a terminal disclaimer.

In section 3 of the Office Action (“Response to Arguments”), the Examiner asserts that the applicant’s arguments regarding the double patenting rejection is not persuasive because the limitations “an outer circumferential frame ... connecting edge portions” and “said one end ... connecting edge portions” are disclosed in claim 9 of application no.

10/057,186.

The Examiner is reminded that as long as the claims are not **identical**, a double patenting rejection under 35 USC 101 is improper. **None of the claims 1-9 of the present application is identical with any claim of application no. 10/057,186**, at least because none of the claims in the present application includes the limitation “said at least one arm member has substantially a rectangular cross section with four curved corners having a predetermined radius of curvature, in a perpendicular direction to a longitudinal direction of said at least one arm member”, as recited by claim 1 of application no. 10/057,186. Since claim 1 is the only independent claim in application no. 10/057,186, this limitation is part of every claim in such application. Moreover, this limitation recites an unusual cross section of the arm member, which is clearly not obvious. Thus, the Applicant believes that **the Examiner should not issue even an obviousness-type double patenting rejection**, not to mention a statutory-type double patenting rejection under 35 USC 101.

Due to the reasons stated above, the Applicant believes that the rejection under 35 USC 101 is obviously improper and should be withdrawn.

Rejections under 35 USC 102(b)

In sections 2-3, the Examiner rejects claims 1-8 under 35 USC 102(b) as being anticipated by Ohyaba et al. (US Patent No. 6,144,753). These rejections are respectfully traversed.

As mentioned in the last response, Ohyaba et al. fails to disclose, suggest, or teach, *inter alia*, the following features recited by claim 1 of the present application:

“an outer circumferential frame having opposite end surfaces and an inner peripheral surface, said inner peripheral surface being connected to said opposite end surfaces to form opposite connecting edge portions”; and

“said one end of said at least one arm member is connected to a portion of said inner peripheral surface of said outer circumferential frame, said portion excluding said opposite connecting edge portions.”

As mentioned in the last response, Ohyaba nowhere mentions “an inner peripheral surface”, or that “said inner peripheral surface being connected to said opposite end surfaces to form opposite connecting edge portions”, or that “said one end of said at least one arm member is connected to a portion of said inner peripheral surface of said outer circumferential frame, said portion excluding said opposite connecting edge portions”, as recited by claim 1 of the present application.

In section 3 of the Office Action (“Response to Arguments”), the Examiner asserts that “Ohyaba clearly discloses the use of an arm member connected to a portion of the inner surface of the outer frame, where the outer frame has opposite end surfaces and an inner peripheral surface (see figure 3)” and that “[t]he inner peripheral surface of Ohyaba is clearly disclosed in figures 2 and 3 and clearly has opposite end surfaces that form connecting edge portions”. The Applicant respectfully disagrees.

It seems that **the Examiner is confused about th** “inn r

**peripheral surface” with the “inner circumferential frame”.** Figs. 2-3 of Ohyaba illustrate a damper having an inner circumferential portion 41 (corresponding to the inner circumferential frame of the present application), an outer circumferential portion 43 (corresponding to the outer circumferential frame of the present application), and a connecting portion 42 (corresponding to the arm members in the present application). The Examiner is asked to review Fig. 2 of the present application carefully before she jumps to any conclusions. Where does Ohyaba mention “an inner peripheral surface” (see numeral 2c in Fig. 2 of the present application), or “inner peripheral surface being connected to said opposite end surfaces to form opposite connecting edge portions”; or “said one end of said at least one arm member is connected to a portion of said inner peripheral surface of said outer circumferential frame, said portion excluding said opposite connecting edge portions”?

Due to the specific construction of the inner peripheral surface and the specific connecting structure of the arm member with the outer circumferential frame, as recited by claim 1, it is possible to prevent the amplitude of the arm member from increasing during excitation of the voice coil, as described in the specification, page 9, lines 3-14. More specifically, connecting the one end of the arm member to the outer circumferential frame in this manner makes it possible to restrict the movement of the arm member, which is caused by oscillation of the inner circumferential frame, through the outer circumferential frame. Thus, the amplitude of the arm member can be decreased and consequently the amplitude of the inner circumferential frame can also be decreased, thus reducing stress.

Clearly, Ohyaha gives no consideration to decrease in amplitude of the arm member and does not teach the above-mentioned limitations of claim 1.

Due to the reasons stated above, the Applicant believes that claim 1 is patentable over the cited reference. Claims 2-8 are also patentable, at least by virtue of their dependency from claim 1. Claim 9 recites, in part, "an inner peripheral surface, said inner peripheral surface being connected to said opposite end surfaces to form opposite connecting circumferential edge portions"; and "said one end of said at least one arm member is connected to a portion of said inner peripheral surface of said outer circumferential frame, said portion excluding said opposite connecting circumferential edge portions so that a thickness of said at least one arm member is smaller than a thickness of said outer circumferential frame". Claim 9 is patentable because these limitations are not taught or suggested in the cited reference.

The Applicant believes that all pending claims are patentable and reconsideration of this application is respectfully requested.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account No. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

Enclosed please find a copy of Troy Guangyu Cai's Notice of Limited Recognition under 35 CFR 10.9(b) to prepare and prosecute patent applications wherein the patent applicant is a client of Ladas & Parry, and the attorney of record in the applications is a registered practitioner who is a member of Ladas & Parry.

I hereby certify that this correspondence is being deposited with the United States Post Office with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on September 4, 2003

\_\_\_\_\_  
(Date of Deposit)

Troy Guangyu Cai

\_\_\_\_\_  
(Name of Person Signing)



\_\_\_\_\_  
(Signature)

9/4/03

\_\_\_\_\_  
(Date)

Respectfully submitted,



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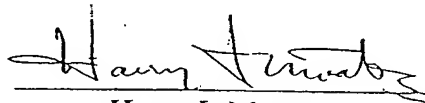
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UNITED STATE PATENT AND TRADEMARK OFFICE**

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Expires: November 19, 2003



Harry I. Moatz  
Director of Enrollment and Discipline